

REMARKS / DISCUSSION OF ISSUES

Claims 1-5, 9-14, and 16-24 are pending in the application.

The Examiner rejects claims 1, 3, 9-11, 13, and 20-24 under 35 U.S.C. 103(a) over Fischer (USPA 2002/0003889) in view of Rast (USPA 2001/0046304). The applicants respectfully traverse this rejection.

The combination of Fischer and Rast fails to teach or suggest a remotely controllable device that is controlled by two controllers, as specifically claimed in independent claim 1. The Examiner relies on the rejection of claim 1 to support the rejection of each of the applicants' independent claims 9, 16, and 20.

The Examiner fails to identify where either Fischer or Rast teaches a remotely controllable device. Both Fischer and Rast disclose a headset that is self-contained. The controllers in each of Fischer and Rast control the elements in the headset; they do not control a remotely controllable device. Both Fischer and Rast disclose the use of a remote audio source, but neither teaches nor suggests controlling such a remote audio source from the controllers in the headset.

Because the Examiner has failed to identify where the combination of Fischer and Rast teaches or suggests each of the elements of claim 1, the applicants respectfully maintain that the rejection of claims 1, 3, 9-11, 13, and 20-24 under 35 U.S.C. 103(a) over Fischer in view of Rast is unfounded, and should be withdrawn.

With regard to dependent claim 13, the combination of Fischer and Rast fails to teach or suggest that the touch-sensitive area of at least one of the controllers detects a pressure with which the touch-sensitive area is touched.

The Examiner notes that Rast detects touch patterns, but fails to identify where Rast teaches detecting a pressure with which the touch-sensitive area is touched. As is well known in the art, a pressure-detecting device differs from a conventional binary switch; a pressure-detecting device provides an output that varies depending upon the amount of pressure being applied. A binary button switch, such as disclosed by Rast, does not detect a pressure with which the button is being pressed.

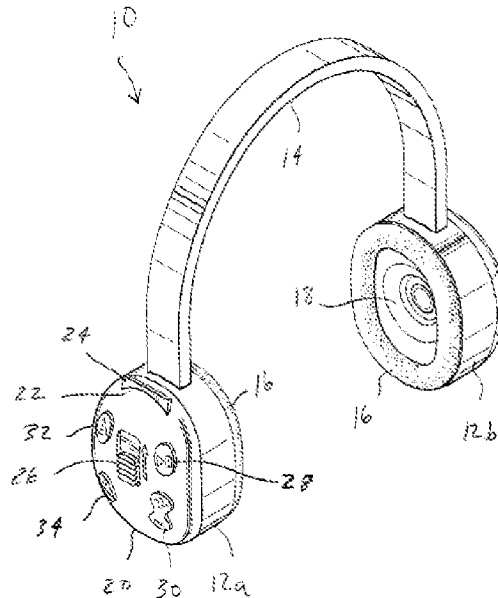
Because the Examiner has failed to identify where the combination of Fischer and Rast teaches or suggests each of the elements of claim 13, the applicants respectfully maintain that the rejection of claim 13 under 35 U.S.C. 103(a) over Fischer in view of Rast is unfounded, and should be withdrawn.

With regard to dependent claim 22, the combination of Fischer and Rast fails to teach or suggest that the indication of touching of the first earbud causes a volume of the output signals to increase, and the indication of touching of the second earbud causes the volume to decrease.

The Examiner acknowledges that the combination of Fischer and Rast fails to disclose this element of claim 22, but asserts that "it would have been the designer's preference to set up the controls in any which order such that the touch control for increasing the volume is on one headset and the touch control for decreasing the volume is on the other headset etc [sic] for the purpose of making the system more dynamic". The applicants respectfully disagree with this assertion.

Placing the opposing volume controls on different earbuds does not "make the system more dynamic", as the term dynamic is generally used in the art. The American Heritage Science dictionary defines dynamic as: "Characterized by continuous change or activity." The particular placement of volume controls will have no effect on the dynamics of either Fischer's or Rast's system.

Further, Fischer specifically discloses the conventional placement of opposing volume controls adjacent each other in FIG. 1:



As is clearly evident, Fischer's element 30 includes both a volume-increase and a volume-decrease control, and Fischer specifically teaches:

"the controls preferably include a stop/start button assembly 28, a volume control assembly 30 for **both increasing and decreasing the volume** of the audio output, a fast forward button assembly 32 for fast forwarding the audio information, and a first backwards button assembly for fast backing-up the audio information." (Fischer [0022], lines 3-9.)

The applicants respectfully maintain that the choice of placing opposing volume controls on the different earbuds is novel and non-obvious, because similar functioning controls are conventionally grouped together. With conventional switches, it is fairly easy to arrange the switches to reduce the likelihood of an erroneous switch selection, such as Fischer's placement of a protruding figure-8 switch with the upper part of the switch corresponding to the "increase" function, and the lower part corresponding to the "decrease" function. Using a touch-sensitive area instead of a plurality of switches, however, the tactile identification of function based on the placement of the switches is absent. The applicants have recognized that by placing opposing controls on different earbuds that are touch-sensitive, the user will quickly learn which earbud to touch to effect the control, and will rarely mistakenly increase the volume when a decrease in volume is desired, and vice versa.

Because the combination of Fischer and Rast fails to teach or suggest that the indication of touching of the first earbud causes a volume of the output signals to increase, and the indication of touching of the second earbud causes the volume to decrease, and because Fischer specifically teaches placing both volume controls on a single earpiece, the applicants respectfully maintain that the rejection of claim 22 under 35 U.S.C. 103(a) over Fischer in view of Rast is unfounded, and should be withdrawn.

The Examiner rejects claims 2, 12, and 14 under 35 U.S.C. 103(a) over Fischer, Rast, and Ito (JP-11-220788). The applicants respectfully traverse this rejection.

Claims 2, 12, and 14 are dependent upon claims 1 and 9, and in this rejection, the Examiner relies on the combination of Fischer and Rast for teaching the elements of claim 1. As noted above, the combination of Fischer and Rast fails to teach or suggest each of the elements of claim 1, and the Examiner has failed to identify where the combination of Fischer and Rast teach or suggest each of the elements of claim 1. Ito does not cure this deficiency. Accordingly, the applicants respectfully maintain that the rejection of claims 2, 12, and 14 under 35 U.S.C. 103(a) that relies on the combination of Fischer and Rast for teaching the elements of claim 1 is unfounded, and should be withdrawn.

Further, MPEP 2143 states:

"THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

The Examiner acknowledges that the combination of Fischer and Rast fails to disclose that each controller is arranged to fit substantially in a human ear concha, such that the touch-sensitive area is accessible for touching when the controller is fitted substantially in the concha, but asserts that it "would have been obvious to modify the system of Fischer and Rast with its dual controlled headset to be utilized

as ear inserts as taught in Ito (Ito, fig. 1, abstract) for the purpose of making the system lighter to carry around." The applicants respectfully disagree with this assertion.

Both Fischer and Rast teach the use of multiple buttons for controlling the functions of the headset. Placing these multiple buttons within the concha would render the combination of Fischer and Rast unsuitable for its intended purpose, because it would be virtually impossible for the user to select the different switches (see Fischer's FIG. 1, above, wherein at least five controls are on one earpiece).

Additionally, Rast's device is designed as an acoustic isolation headset. As is well known in the art, conventional acoustic isolation headsets rely on the entire ear being covered by the earpiece. Reducing Rast's design to fit within the concha would render Rast's device unsuitable for its intended purpose of acoustic isolation.

Because there is no apparent reason to combine Fischer, Rast, and Ito in the manner proposed by the Examiner, and because the combination of Fischer, Rast, and Ito would not be suitable for its intended purpose, the applicants respectfully maintain that the rejection of claims 2, 12, and 14 under 35 U.S.C. 103(a) over Fischer, Rast, and Ito is unfounded, and should be withdrawn.

The Examiner rejects claims 4-5 and 17-19 under 35 U.S.C. 103(a) over Fischer in view of Rast and Boesen (USP 6,560,468). The applicants respectfully traverse this rejection.

Claims 4-5 and 17-19 are dependent upon claims 1 and 16, and in this rejection, the Examiner relies on the combination of Fischer and Rast for teaching the elements of claim 1. As noted above, the combination of Fischer and Rast fails to teach or suggest each of the elements of claim 1, and the Examiner has failed to identify where the combination of Fischer and Rast teaches or suggests each of the elements of claim 1. Boesen does not cure this deficiency. Accordingly, the applicants respectfully maintain that the rejection of claims 4-5 and 17-19 under 35 U.S.C. 103(a) that relies on the combination of Fischer and Rast for teaching the elements of claim 1 is unfounded, and should be withdrawn.

Additionally, the combination of Fischer, Rast, and Boesen fails to teach or suggest a second touch-sensitive area that is touched substantially by the ear when the controller is substantially worn in or by a human ear, the controller being arranged to send a corresponding control signal only if the second touch-sensitive area is touched, as specifically claimed in claim 4. The Examiner relies on the rejection of claim 4 to support the rejection of claims 17-19.

The Examiner asserts that Boesen's conduction sensor is a controller that is worn in or by a human ear. This assertion is incorrect. Boesen's conduction sensor 22 is a piezoelectric device that acts as a microphone by detecting the bone vibrations caused when a person speaks. These signals are communicated to a signal processor 40. Boesen's signal processor 40 is not a controller, and specifically does not communicate a control signal when the conduction sensor is touched, as asserted by the Examiner.

Because the combination of Fischer, Rast, and Boesen does not teach or suggest a second touch-sensitive area that is touched substantially by the ear when the controller is substantially worn in or by a human ear, the controller being arranged to send a corresponding control signal only if the second touch-sensitive area is touched, the applicants respectfully maintain that the rejection of claims 4 and 17-19 under 35 U.S.C. 103(a) over Fischer, Rast, and Boesen is unfounded, and should be withdrawn.

Further, in *KSR Int'l. Co. v. Teleflex, Inc.*, the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed:

"Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**." KSR, 82 USPQ2d 1385 at 1396 (emphasis added).

The Examiner asserts that the motivation of combining Fischer, Rast, and Boesen is "for the purpose of the system being dynamic". The applicants respectfully maintain that this assertion does not conform to the standards established in *KSR*.

The applicants respectfully maintain that the status of a system being dynamic does not provide an apparent reason for combining the teachings of a variety of diverse applications (a headset with removable storage (Fischer), a headset for acoustic isolation (Rast), and a microphone/speaker for a cell phone (Boesen)). The "dynamics" of any of the systems of Fischer and Rast are not affected by the means used to embody the controllers of these systems, and particularly not by the existence of the cell phone microphone/speaker arrangement of Boesen. The fact that Fischer's or Rast's devices may be dynamic does not provide an apparent reason for combining an aspect of a microphone/speaker arrangement disclosed by Boesen with these devices. The only motivation for embodying a controller that sends a control signal only if a touch-sensitive area is touched by the ear when the controller is worn in or by a human ear is provided solely by the applicants' disclosure.

Accordingly, because there is no apparent reason, absent the applicants' disclosure, to combine Fischer, Rast, and Boesen in the manner proposed by the Examiner, the applicants respectfully maintain that the rejection of claims 4-5 and 17-19 under 35 U.S.C. 103(a) over Fischer in view of Rast and Boesen is unfounded, and should be withdrawn.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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